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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/656,187	09/06/2000	David Itzhak	9124.118US01	8930

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EXAMINER	
PHASGE, ARUN S	

ART UNIT	PAPER NUMBER
1753	17

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/656,187	ITZHAK, DAVID	
	Examiner	Art Unit	
	Arun S. Phasge	1753	

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Peri d for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 May 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14 and 17-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *5-7 and 17-19* is/are allowed.

6)☒ Claim(s) *1-4, 8-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4, 8-13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura in view of Fleischman of record for reasons of record.

Claim 14 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura in view of Fleischman as applied to claims above, and further in view of Hudson of record for reasons of record.

Response to Arguments

Applicant's arguments filed 5/19/03 have been fully considered but they are not persuasive.

Applicants argue that Nakamura does not teach the use of wastewater as the makeup water and the Fleischman reference does not teach the water treatment method for a cooling tower as recited in claim 1.

Applicant has pointed out the deficiencies in each of the references. However, the rejection is based on the combination of references. The test of obviousness under 35 U.S.C. §103 is not the express suggestion of the claimed

invention in any or all of the references, but what the references taken collectively would suggest to those of ordinary skill in the art presumed to be familiar with them. *Ex parte Obiaya*, 227 U.S.P.Q. 59 BDAPP (1985).

Applicant further argues that the combination would not arrive at the present invention, since Fleischman does not suggest that there might be treatment of the water and Nakamura does not suggest that its treatment methods might be applicable to wastewater coolant.

The Nakamura patent does suggest that its treatment methods might be applicable to wastewater coolant, because the water is used in a cooling tower (col. 2, lines 1-5) and further the water is treated and reused. Webster's dictionary defines "wastewater" as water that has been used. Accordingly, the reference uses "wastewater" in a cooling tower. The water recycled would contain organic and/or biological contaminants, since COD is measured to provide an index of pollution (see abstract).

Therefore, contrary to applicant's argument the Nakamura patent would be applicable to treat water containing contaminants, since it continually monitors and treats water electrolytically to obtain water re-usable in a variety of different

situations. The Fleischman patent further teaches the re-use of wastewater as cooling tower makeup water rather than wasting the wastewater.

With respect to the argument that there is no teaching or suggestion to combine the references, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 U.S.P.Q. 607. However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re Simon, 174* U.S.P.Q. 114; *In re McLaughlin*, 170 U.S.P.Q. 209. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 U.S.P.Q. 545.

All that is required to show obviousness is that the applicant "make his claimed invention merely by applying knowledge clearly present in the prior art. Section 103 requires us to presume full knowledge by the inventor of the prior art in the field of his endeavor." *In re Winslow*, 151 U.S.P.Q. 48 CCPA (1966).

Consequently, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the disclosure of the Nakamura patent with the teachings of Fleischman reference, because the Nakamura patent discloses the continuous process of testing the "wastewater" and electrolytically treating the same to obtain treated water which is reused and the Fleischman reference teaches the use of wastewater as makeup water to obtain an economic advantage.

Likewise, the Hudson patent is cited to show the benefits that the use of a sand filter to remove particles produces (col. 4, lines 44-56). Therefore, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the disclosure of Nakamura to use the sand filter of Hudson, because the Hudson patent teaches the improvement to the removal of particles.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is

filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun S. Phasge whose telephone number is (703) 308-2528. The examiner can normally be reached on MONDAY-THURSDAY, 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam X Nguyen can be reached on (703) 308-3322. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Arun S. Phasge
Primary Examiner
Art Unit 1753

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August 11, 2003